

REMARKS/ARGUMENTS

Claims 1-39 are pending in the present application. Claims 1, 18, 21 and 35 are independent claims.

INITIALED PTO-1449 NEEDED

Applicants once again request the Examiner to initial and return the PTO-1449 submitted with the IDS filed on June 13, 2001. A copy of this PTO-1449 is attached hereto for convenience.

35 U.S.C. § 103 REJECTION

Claims 1-4, 8-25, and 30-39 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Leiman et al. (U.S. Patent 6,469,976) in view of Murphy et al. (U.S. Patent No. 6,076,110). This rejection, insofar as it pertains to the presently pending claims, is respectfully traversed.

First, Applicants wish to point out that the Examiner's rejection as stated in the Office Action is unclear. On page 2 of the Office Action, the Examiner alleges that Leiman et al. teaches receiving a selection of a processing device. However, on page 3 of the same Office Action, the Examiner contradicts himself and states that Leiman et al. does not explicitly teach receiving a selection of a processing device and thus relies on Murphy et al. If the Examiner were to maintain this rejection, a clarification is requested. Regardless, the claims are allowable over the applied references for the following reasons.

Leiman et al. is directed to a printing system having multiple printers available for processing print jobs. In order to select an appropriate printer for printing a certain print job, Leiman et al. proposes a working method as follows. Firstly, at the GUI of a workstation, an overview is given of the printers that are part of the networked system as shown in Figure 6. A status such as "active", "idle", "unavailable" or "offline", of each of the printers is indicated. Secondly, in order to perform a print job, the operator selects a job (column 7, lines 65-66 of Leiman et al.). When the job appears to have a ready status, the job can be printed by selecting the print option and a desired printer (column 8, lines 6-8 of Leiman et al.). In Leiman et al., it is only *after* the desired printer has been selected, that the system checks whether the set-up of the selected printer matches the print-job set-up. If the set-ups do not match, the print job cannot be printed and a new selection of a printer has to be made by a user.

One disadvantage of Leiman et al. system is that the user has to make a selection of a printer and only *after* that, it is checked whether that printer is suitable for performing the job. If the selected printer is not suitable, printing is prohibited and the user has to make a new printer selection. Again, the user has to wait to know if the newly selected printer is suitable for performing the print job. If the newly selected printer is not suitable, the user has to make yet another selection and this process continues until the user selects a printer

that is suitable for performing the print job. Such a method can be extremely time consuming and frustrating to the user.

In clear contrast, in Applicant's embodied invention, the system automatically checks whether all processing devices belonging to a predetermined set selected from a plurality of processing devices are suitable for performing the print job, and presents, for each processing device of this set, whether that processing device is suitable for performing the job. Only after that, the user selects a processing device from the set of processing devices to perform the job. These features are completely absent from Leiman et al. Independent claims 1 and 21 emphasize these distinctions. According to the present invention, the automatic check for suitability of the processing devices is made before the user selects a certain processing device from this set and thus, the outcome of this check can be used by the user to make an appropriate selection.

Furthermore, Murphy et al. does not overcome these deficiencies of Leiman et al. since Murphy et al. is directed to the process of negotiating operations between a server and a client. In Murphy et al., client 60 requests one of the virtual device names representing particular devices that exist in the client system. If the virtual device name does not exist for a device when requested, then it is created. Thus, Murphy et al. involves merely communicating a device name from a client to a server and has nothing to do with automatically checking the suitability of printers for a print job and

making a selection from the printers based on the indication of suitability of the printers.

Therefore, even if the references are combinable, assuming *arguendo*, the combination of references would still fail to teach or suggest, *inter alia*

automatically checking whether all processing devices belonging to a predetermined set selected from the plurality of processing devices are suitable for performing the job . . .

after that, receiving a selection of a processing device belonging to the set

as recited in independent claim 1; and

research means for checking whether all processing devices belonging to a predetermined set selected from the plurality of processing devices are suitable for performing the defined job. . .

selected means for selecting a processing device from the set based on the indication

as recited in independent claim 21.

Regarding independent claims 18 and 35, the Examiner alleges that Leiman et al. teaches indicating if the device is not suitable. However, claim 18 requires, *inter alia*, "indicating, if the processing device is not-suitable for performing the job, a reason therefore." Claim 35 recites similar features. Leiman et al. merely teaches indicating that the print job cannot be printed, but does not indicate a reason for the non-suitability, which is required by claims 18 and 35. Murphy et al. does not overcome this deficiency of Leiman et al. since Murphy et al. is merely directed to communicating a device name

from a client to a server over a network. Thus, the combination of these references does not render obvious the invention as recited in claims 18 and 35.

Accordingly, independent claims 1, 18, 21, and 35 and their dependent claims (do to their dependency) are patentable over the applied references, and the rejection must be withdrawn.

Claims 5-7, 26, and 27-29 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Leiman et al. in view of Murphy et al. and further in view of Applicants' disclosed background art. This rejection, insofar as it pertains to the presently pending claims, is respectfully traversed.

As discussed above, the combination of Leiman et al. and Murphy et al. does not teach or suggest the invention as recited in independent claims 1 and 21 from which claims 5-7 and 26-29 depend. Furthermore, Applicants' disclosed background art does not overcome this deficiency since Applicants' invention is invented to overcome the limitations of Applicants' background art and the Examiner merely relies on Applicants' disclosed background art to teach a part of a job being a setting of a job.

Therefore, even if the references are combinable, assuming *arguendo*, the combination of reference would still fail to teach or suggest the invention as recited in independent claims 1 and 21 and their dependent claims due to their dependency. Accordingly, the rejection is improper and must be withdrawn.

CONCLUSION

For the foregoing reasons and in view of the above clarifying amendments, Applicants respectfully request the Examiner to reconsider and withdraw all of the objections and rejections of record, and earnestly solicit an early issuance of a Notice of Allowance.

Should there be any matters which need to be resolved in the present application, the Examiner is respectfully requested to contact Esther H. Chong (Registration No. 40,953) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and further replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASH & BIRCH, LLP

By 
Raymond C. Stewart, #21,066

P.O. Box 747
Falls Church, VA 22032-0747
(703) 205-8000

^{SW}
RCS/EHC:kss